



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,825	02/04/2004	Katsuhiko Hasegawa	CONDA.00019	3959

22858 7590 05/20/2005

CARSTENS YEE & CAHOON, LLP  
P O BOX 802334  
DALLAS, TX 75380

EXAMINER

PAYER, HWEI SIU CHOU

ART UNIT	PAPER NUMBER
----------	--------------

3724

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/771,825

Applicant(s)

HASEGAWA, KATSUHIKO

Examiner

Hwei-Siu C. Payer

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-20 is/are rejected.
- 7) ☒ Claim(s) 4-7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **Detailed Action**

### **Drawings Objection**

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the slip-guard as cited in claim 11 must be shown or the feature canceled from the claim. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

**Claims Rejection - 35 U.S.C. 112, first paragraph**

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 14-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(1) In claim 14, lines 3-4 and 5, "the end of pin" has no support from the original specification. The phrase should read --the head of the pin--.

(2) In claim 15, line 3, "greater than a diameter of the end of the pin" and "smaller than the diameter of the end of the pin" have no support from the specification as originally filed. The phrases should read --greater than a diameter of the head of the pin-- and-- smaller than the diameter of the head of the pin--, respectively (see page 8 of the specification).

(3) In claim 16, line 2, "the diameter of the pin" should read --the diameter of the head of the pin-- (see page 8 of the specification).

**Claims Rejection - 35 U.S.C. 102(b)**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gray (U.S. Patent No. 4,423,729).

**Claims Rejection - 35 U.S.C. 103(a)**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray (U.S. Patent No. 4,423,729).

Gray's cap (14) shows all the claimed structure except the sidewalls of the cap tapered that than curved toward each other.

However, the claimed limitation is not patentably distinct over Gray because as long as the cap is capable of shielding the scissors yet allowing opening and closing of the scissor blades for cutting a workpiece, whether cap's sidewalls are tapered or

curved toward each other depends more upon personal preference than on any inventive concept.

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gray (U.S. Patent No. 4,423,729) in view of Gingher, Jr. (U.S. Patent No. 4,400,877).

Gray's cap (14) shows all the claimed structure except it lacks a slip-guard on the sides of the cap body.

Gingher, Jr. shows a cap (12) comprising a slip-guard (i.e. textured on the side of the cap).

It would have been obvious to one skilled in the art to modify Gray by providing the cap (14) with a slip-guard for preventing slippage of the cap as taught by Gingher, Jr.

4. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray (U.S. Patent No. 4,423,729) in view of Linden (U.S. Patent No. 5,291,996).

Gray shows the claimed cap except the engaging portion (40a,40b) is in the form of a hole rather than a slit.

Linden shows a cap (Fig.2) for a pair of scissors, wherein the cap comprises an engaging slit including a guiding portion (44), a holding portion (42) and a cutout (48) for releasably securing the cap to the scissors.

It would have been obvious to one skilled in the art to modify Gray by substituting Linden's engaging slit for the engaging hole to afford a quick release of the cap from the scissors without the use of a tool as taught by Linden.

5. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray (U.S. Patent No. 4,423,729) in view of Rauh (U.S. Patent No. 1,870,025).

Gray shows the claimed scissors except it lacks an urging member.

Rauh shows a pair of scissors having an urging member (7) for moving two scissor pieces (1,3).

It would have been obvious to one skilled in the art to modify Gray by providing the scissors with an urging member for moving the scissor pieces (24,26) away from each other to facilitate receiving a workpiece to be cut as taught by Rauh.

#### **Indication of Allowable Subject Matter**

Claims 4-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **Prior Art Citations**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Malsin, Steinhardt, Metzger, Stilwell et al., Kobelt, Linden '159, Ohmura and DiPalma are cited as art of interest.

### Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 571-272-4511. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for official communications and 571-273-4511 for proposed amendments.

H Payer  
May 17, 2005

*Hwei-Siu Payer*  
Hwei-Siu Payer  
Primary Examiner